

Amendments to the Drawings

As requested in the Action, a Replacement Drawing sheet including Figure 1 is attached herewith. Figure 1 has been corrected as suggested in the Action to show a "receipt printer" (25) connected to the computer processor as described with respect to Figure 1 in the Specification at paragraph [0039]. In addition, Figure 1 has been corrected to remove the extraneous word "therefore" in the box labeled "Communication Port" (28).

No new matter will be added as a result of this substitution. Permission to amend the drawings by substitution is respectfully requested.

REMARKS

Claims 18 and 27 have been amended herein. Claims 33-39 have been added. Claims 1-41 are now pending in the Application. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

Claim 18 has been amended to depend from claim 17.

Claim 27 has been amended to correct a grammatical error.

Drawing/Specification Objections

In the Action, the Specification and the Drawings were objected to because Figure 1 did not include "a receipt printer 25" as described for Figure 1 in the Specification at paragraph [39]. This objection is respectfully traversed. Figure 2 shows a receipt printer which is labeled with reference numeral "25". Nevertheless, to make the Specification even more clear, Figure 1 has been amended herein as suggested in the Action to show "a receipt printer" labeled with reference number "25".

In addition, the Action asserted that reference numerals 19, 50, and 52-54 were not mentioned in the disclosure with respect to Figure 1. This objection is respectfully traversed. Applicants respectfully submit that reference numbers 19, 50, and 52-54 are discussed in the Specification at paragraphs [0044] and [0045]. Although Applicants believe the Specification is clear and consistent with the Drawings, to make the Specification even more clear, Applicants have amended the Specification herein to insert "Referring to Figures 1 and 2" at the beginning of paragraph [0044]. No new matter has been added. Applicants respectfully submit that these

amendments to the Drawings and Specification obviate the objections to the Drawings as asserted in the Action.

Abstract Objections

In the Action, the Abstract was objected to because of the inclusion of reference numerals. This objection is respectfully traversed. MPEP § 608.01(b) referenced in the Action does not require reference numerals to be removed from an Abstract. In addition, a basic search of U.S. patents granted since 1976 at the Office's web site www.uspto.gov reveals that over 121,000 U.S. patents have been granted which have the reference numeral "10" in their Abstracts.

Nevertheless, although reference numerals are permitted in Abstracts, Applicants have amended the Abstract herein to remove all reference numerals. In addition, a typographical error has been corrected in the Abstract. The article --a-- has been inserted before the word "checking". No new matter has been added. Applicants respectfully submit that the new Abstract obviates the objection.

Claim Objections

In the Action, dependent claim 18 was objected to for depending from claim 16 even though intervening claim 17 does not depend from claim 16. This objection is respectfully traversed.

Claim 18 has been amended herein to correct a typographical error. Claim 18 should depend from claim 17 and not from claim 16. The amendment to claim 18 herein obviates the objection.

The Pending Claims Are Not Obvious in View of the Applied Art

Claims 1-3, 5-6, 8-10, 19-21, 23, and 25-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Drummond, et al., U.S. Patent No. 6,289,320 ("Drummond") and further in view of Schneier, *Applied Cryptography* ("*Schneier*").

Claims 4, 7, 11-16, 18, and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Drummond and Schneier as applied to claims 1 and 20 and further in view of Zajkowski, et al., U.S. Patent No. 6,705,517 ("Zajkowski").

Claims 17 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Drummond and Schneier as applied to claims 1 and 20 and further in view of Meurer, U.S. Patent Application Publication No. 2004/0215566.

These rejections are respectfully traversed.

**The Applied References Do Not Disclose or Suggest
the Features and Relationships Recited in Applicants' Claims**

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are

known in the prior art. If the Office does not produce a *prima facie* case, then the Applicants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

It is respectfully submitted that the Action does not meet these burdens.

The Drummond and Zajkowski References Do Not Qualify As Prior Art

The present application claims the benefit under 35 U.S.C. § 119 (e) of U.S. Provisional Application Numbers 60/273,996 filed March 7, 2001 and 60/319,015 filed November 29, 2001. The Drummond Reference issued on September 11, 2001 and the Zajkowski reference issued on March 16, 2004. As the present application is entitled to a filing date that is earlier than the issue dates of Drummond and Zajkowski, it follows that the 35 U.S.C. § 103(a) rejections flow from

35 U.S.C. § 102(e). However, 35 U.S.C. § 102(e) specifically requires that the qualifying prior art must be a patent granted on an application for a patent **by another**.

The Applicant Mark D. Smith is an inventor common to the present application and the patents of Drummond and Zajkowski. Thus the Drummond and Zajkowski references are not **by another** and therefore do not qualify as prior art under 35 U.S.C. § 103(a).

In addition, the inventions claimed in the present application and described in the Drummond and Zajkowski reference were subject to an obligation of assignment (and were assigned) to a common entity, namely Diebold, Incorporated. Thus the Drummond and Zajkowski references do not qualify as prior art under 35 U.S.C. § 103(a) pursuant to 35 U.S.C. § 103(c).

As all of the pending claims 1-32 were rejected in view of Drummond, it follows that the rejections of claims 1-32 are improper and should be withdrawn.

The Portions Relied On In Meurer Do Not Qualify As Prior Art

Meurer claims benefit of U.S. Provisional Application No. 60/255,985 filed December 15, 2000. Although the Meurer '985 provisional should be readily accessible to the Office, as a courtesy, Applicants have attached herewith a copy of the Meurer '985 provisional, which was downloaded from the Office's Image File Wrapper system available at www.uspto.gov. The Meurer '985 provisional appears to be a User's Manual for a software package entitled "ATM Manager Pro" and does not have a written description which directly corresponds to the written description in the Meurer publication US 2004/0215566 A1.

Although the filing date of the Meurer '985 provisional is earlier than Applicants' earliest priority filing date of March 7, 2001, Applicants have been unable to identify where paragraph

[0013] of Meurer appears in the Meurer '985 provisional. Thus paragraph [0013] which was relied on in the Action to support the rejections of claims 17 and 24 does not qualify as prior art.

Applicants respectfully submit that in addition to withdrawing the rejections of claims 17 and 24 because Drummond does not qualify as prior art, the rejections of claims 17 and 24 should also be withdrawn because the portions of Meurer relied on in the Action also do not qualify as prior art.

Furthermore, even if paragraph [0013] of Meurer did qualify as prior art, Applicants respectfully disagree that the discussion in paragraph [0013] provides any teaching, suggestion or motivation to assess a digital signature processing fee as recited in claims 17 and 24.

**The Pending Claims Are Not Obvious Over
Drummond in view of Schneier**

In the Action claims 1-3, 5-6, 8-10, 19-21, 23, and 25-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Drummond in view of Schneier. These rejections are respectfully traversed. Applicants' response to these rejections is based on the Office's referenced interpretations of Drummond and Schneier. Thus, any change in the Office's interpretation of these references shall constitute a new ground of rejection.

In addition to Drummond not qualifying as prior art, Applicants further traverse these rejections on the grounds that Applicants' claims recite features and relationships which are neither disclosed nor suggested in the applied art, and because there is no teaching, suggestion or motivation cited so as to produce Applicants' invention. The features recited in Applicants' claims patentably distinguish over the applied references.

Claim 1

Claim 1 is an independent claim which is directed to an apparatus. Claim 1 recites that the apparatus comprises "at least one computer processor; and at least one data store in operative connection with the computer processor, wherein the at least one data store includes a plurality of digital safe deposit accounts stored therein".

The Action asserts that Drummond teaches a data store which includes a plurality of digital safe deposit accounts stored therein at column 10, lines 24-34 and column 15, line 62 to column 16, line 5. Applicants disagree. Column 10, lines 24-34 of Drummond states the following:

The home HTTP server 90 is preferably in communication with a data store and is in electronic communication with a back office computer system, schematically indicated 94. Back office computer system 94 is operative to keep track of debiting or crediting customers' accounts when they conduct transactions at the automated banking machines. In addition back office 94 is also preferably operative to track transactions for purposes of accomplishing settlements with other institutions who are participants in the system and whose customers conduct transactions at the ATMs 12.

In addition column 15, line 62 to column 16, line 5 of Drummond states the following:

It should be noted that the page or screen which requests the customer to enter their PIN is shown generated from the home HTTP server 90. This is preferably a screen that is associated with the particular customer's URL address. This will be the interface of the customer's home bank and will be familiar to the customer.

Alternatively, the customer address may access what may be essentially the customer's personal "home page" with the institution that operates computer system 14. As such, it is not only something the user is familiar with, but is ideally tailored to the user's particular transaction needs.

Neither of these portions of Drummond discuss a "digital safe deposit account".

In addition, claim 1 recites that "each of the digital safe deposit accounts is associated with at least one private key". The Action asserts that Drummond teaches this feature at column 15, lines 9-43. Applicants disagree. Column 15, lines 9-43 of Drummond discusses the verification by an HTTP server or by an ATM of a PIN which is entered through a keyboard of the ATM. Drummond does not disclose or suggest that each of a plurality of digital safe deposit accounts stored in a data store is associated with at least one private key.

Further, claim 1 recites that "the computer processor is operative responsive to at least one of the ATMs to cause a digital signature to be produced for an electronic document responsive to the private key associated with one of the digital safe deposit accounts". The Action asserts that a portion of this recited feature in claim 1 is taught by Drummond at column 14, lines 10-38, with this portion of claim 1 being: "the computer processor is operative responsive to at least one of the ATMs to cause a digital signature to be produced for an electronic document". Applicants disagree. Column 14, lines 10-38 of Drummond discusses that an HTML document includes embedded Java script which has a digital signature associated with a home HTTP server. This portion of Drummond also discusses that an HTTP record includes an instruction used to operate a transaction function device and data representative of a digital signature. However nowhere does this portion of Drummond disclose or suggest that a

computer processor is responsive to at least one of a plurality of ATMs to cause a digital signature to be produced for an electronic document.

Further, the Action acknowledges that Drummond does not disclose an apparatus wherein the computer processor is operative responsive to at least one of the ATMs to cause a digital signature to be produced for an electronic document responsive to the private key associated with one of the digital safe deposit accounts. To overcome this admitted deficiency in Drummond, the Action asserts that Schneier teaches that public-key algorithms can be used for digital signatures by using a private key for the encryption. The Action further asserts that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the method disclosed in Drummond to cause the digital signature for an electronic document to be created responsive to the private key. The Action also asserts that this modification would have been obvious because a person having ordinary skill in the art, at the time of the invention was made, would have been motivated to do so since it is suggested by Schneier on page 37, lines 16-20.

Applicants disagree. The referenced portion of Schneier does not suggest modifying the method disclosed in Drummond as asserted in the Action. Further, Schneier does not disclose or suggest the features recited in claim 1 which are missing from Drummond. As discussed previously, Drummond does not disclose or suggest producing a digital signature for an electronic document responsive to an ATM. In addition, Schneier's discussion of how to generate a digital signature does not disclose or suggest doing so responsive to an ATM. Nowhere does Schneier disclose or suggest the admitted feature missing from Drummond, of a computer processor that is operative to cause a digital signature to be produced for an electronic document responsive to both: **at least one of the ATMs;** and the **private key associated with**

one of the digital safe deposit accounts. As neither Drummond nor Schneier discloses or suggests each and every feature and relationship recited in the claim, the Office has failed to establish *prima facie* obviousness.

Furthermore, even if the applied references did separately disclose each of the features and relationships recited in claim 1 (which they do not), the Action has still failed to show a prior art teaching, suggestions, or motivation to combine the references to form the apparatus recited in claim 1.

For example, the Actions refers to portions of Drummond which discuss a PIN. The Action does not expressly state how a PIN is relevant to claim 1. Thus Applicants have been forced to speculate as to how a PIN may be related to claim 1. In this regard, Applicants presume that the Action may be arguing that the PIN discussed in Drummond corresponds to a teaching of the private key recited in claim 1. In addition, the Action refers to portions of Drummond which discuss digital signatures with respect to Java script and an HTTP record with an instruction for operating devices. However, the Action has failed to show any connection between a PIN and a digital signature with regard to the features recited in claim 1. For example, nowhere in either Drummond or Schneier is there discussed or suggested a need to produce a digital signature responsive to a PIN. Further, nowhere does Drummond or Schneier disclose or suggest using a PIN with a public-key algorithm. In addition, nowhere does Drummond or Schneier disclose or suggest that the PIN described in Drummond corresponds to a public-key algorithm private key which is capable of generating a digital signature for an electronic document.

The Applicants respectfully submit that the attempts to combine the teachings of the references are clearly attempts at hindsight reconstruction of Applicants' claimed invention,

which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Applicants' disclosure. It follows that it would not have been obvious to have modified the references in the manner alleged.

As discussed previously, Drummond does not qualify as prior art. In addition, even if Drummond qualified as prior art (which it does not), Applicants respectfully submit that the Office has not established *prima facie* obviousness. Drummond and Schneier do not disclose or suggest each and every element, feature, and relationship of the claimed invention arranged in the manner recited in the claim, as is required to sustain the rejection. Nowhere does Drummond and Schneier disclose or suggest a plurality of digital safe deposit accounts stored in a data store which are each associated with at least one private key. Further neither reference discloses or suggests a computer operative to communicate with a plurality of ATMs, and which is responsive to one of the ATMs to cause a digital signature to be produced for an electronic document responsive to the private key associated with one of the digital safe deposit accounts. Nor is there any prior art teaching, suggestion, or motivation cited for modifying Drummond in view of Schneier so as to produce the claimed invention. Further, it would not have been obvious to one having ordinary skill in the art to have modified Drummond in view of Schneier to have produced the claimed invention. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 1 is improper and should be withdrawn. It follows that claims 2-19 which depend from claim 1 are also allowable.

Claim 20

Claim 20 is an independent claim which is directed to a method. The method comprises a) receiving a financial account number from an automated transaction machine; b) accessing a private key associated with the financial account number; and c) enabling an electronic document displayed by the automated transaction machine to be digitally signed with the private key.

Applicants disagree with the Assertions made in the Action regarding the teachings of Drummond with respect to the steps recited in claim 20. Nowhere does Drummond disclose or suggest:

- enabling an electronic document displayed by the automated transaction machine to be digitally signed.

As discussed previously, the portions of Drummond referenced at column 14, lines 10-28 discuss Java script and an HTTP record with an instruction used to operate devices which have digital signatures. Drummond does not disclose or suggest that the Java script or an HTTP record with an instruction for operating devices which include digital signatures are displayed by an automated transaction machine. Thus Drummond does not disclose or suggest enabling an electronic document "displayed by the automated transaction machine" to be digitally signed.

In addition, the Action admits that Drummond does not disclose or suggest enabling an electronic document displayed by the automated transaction machine to be digitally signed with the private key. However, the Action asserts that Schneier teaches that public-key algorithms can be used for digital signatures by using a private key for the encryption and that it would therefore have been obvious to a person in the art at the time of the invention was made to modify the method disclosed in Drummond to digitally sign the electronic document with the private key.

The Action asserts that this modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Schneier on page 37, lines 16-20.

Applicants disagree. Schneier's discussion at pages 37, lines 16-20 does not suggest modifying the method disclosed in Drummond as asserted in the Action. Further, Schneier does not disclose or suggest the features recited in claim 20 which have been shown previously to be absent from Drummond. For example, Schneier's discussion of how to generate a digital signature does not disclose or suggest enabling an electronic document displayed by the automated transaction machine to be digitally signed with a private key associated with a financial account number received from the automated transaction machine.

Neither Schneier nor Drummond alone or in combination disclose or the method steps of: **accessing a private key associated with the financial account number; and enabling an electronic document displayed by the automated transaction machine to be digitally signed with the private key.** As neither Drummond nor Schneier discloses or suggests each and every feature, relationship, and step recited in the claim, the Office has failed to establish *prima facie* obviousness.

Furthermore, even if the applied references did separately disclose each of the features and relationships recited in claim 20 (which they do not), the Action has still failed to show a prior art teaching, suggestion, or motivation to combine the references to produce the method recited in claim 20. As discussed previously, the Action references Drummond's discussion of a PIN entered through a keyboard of an ATM. However, nowhere in either Drummond or Schneier is there disclosed or suggested a need to produce a digital signature responsive to a PIN.

Further, nowhere does Drummond or Schneier disclose or suggest using a PIN with a public-key algorithm. In addition nowhere does Drummond or Schneier disclose or suggest that the PIN described in Drummond corresponds to a public-key algorithm private key which is capable of generating a digital signature for an electronic document.

The Applicants respectfully submit that the attempts to combine the teachings of the references are clearly attempts at hindsight reconstruction of Applicants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Applicants' disclosure. It follows that it would not have been obvious to have modified the references in the manner alleged.

As discussed previously, Drummond does not qualify as prior art. In addition, even if Drummond qualified as prior art (which it does not), Applicants respectfully submit that the Office has not established *prima facie* obviousness with respect to claim 20. Drummond and Schneier do not disclose or suggest each and every element, feature, and relationship of the claimed invention arranged in the manner recited in the claim, as is required to sustain the rejection. Nor is there any prior art teaching, suggestion, or motivation cited for modifying Drummond in view of Schneier so as to produce the claimed invention. Further, it would not have been obvious to one having ordinary skill in the art to have modified Drummond in view of Schneier to have produced the claimed invention. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 20 is improper and should be withdrawn. It follows that claims 21-26 which depend from claim 20 are also allowable.

Claim 27

Claim 27 is an independent claim which is directed to a method. The method comprises:

- a) receiving a request from an automated transaction machine to digitally sign an electronic document visually displayed by the automated transaction machine, wherein the request includes an account number that is associated with a digital safe deposit account; b) accessing a private key associated with the digital safe deposit account responsive to the account number; c) producing a digital signature for the electronic document responsive to the private key; and d) causing the digital signature to be attached to the electronic document.

Applicants disagree with the Assertions made in the Action regarding the teachings of Drummond with respect to the steps recited in claim 27. Nowhere does Drummond disclose or suggest:

- receiving a request from an automated transaction machine to digitally sign an electronic document visually displayed by the automated transaction machine;
- wherein the request includes an account number that is associated with a digital safe deposit account;
- accessing a private key associated with the digital safe deposit account responsive to the account number;
- producing a digital signature for the electronic document visually displayed by the automated transaction machine; or
- causing the digital signature to be attached to the electronic document visually displayed by the automated transaction machine.

As discussed previously, the portions of Drummond referenced at column 14, lines 10-28 discuss Java script and an HTTP record with an instruction used to operate devices which have digital signatures. Drummond does not disclose or suggest that the Java script or HTTP record with an instruction for operating devices which include digital signatures are displayed by an automated transaction machine. Thus Drummond does not disclose or suggest producing a digital signature for the electronic document "visually displayed by the automated transaction machine".

In addition, the Action admits that Drummond does not disclose or suggest producing a digital signature for the electronic document responsive to the private key. However, the Action asserts that Schneier teaches that public-key algorithms can be used for digital signatures by using a private key for the encryption, and that it would therefore have been obvious to a person in the art at the time of the invention was made to modify the method disclosed in Drummond to digitally sign the electronic document with the private key. The Action asserts that this modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Schneier on page 37, lines 16-20.

Applicants disagree. The referenced portion of Schneier at page 37, lines 16-20, does not suggest modifying the method disclosed in Drummond as asserted in the Action. Further, Schneier does not disclose or suggest the features recited in claim 27 which are missing from Drummond. For example, Schneier's discussion of how to generate a digital signature does not disclose or suggest producing a digital signature for an electronic document displayed by the automated transaction machine, responsive to a private key associated with a digital safe deposit account number received from the automated transaction machine. Thus neither Schneier nor

Drummond alone or in combination disclose or suggest the method steps of: **accessing a private key associated with a digital safe deposit account responsive to an account number received from an automated transaction machine; and producing a digital signature for the electronic document visually displayed by the automated transaction machine responsive to the private key.**

As neither Drummond nor Schneier discloses or suggests each and every feature, relationship, and step recited in the claim, the Office has failed to establish *prima facie* obviousness. Furthermore, even if the applied references did separately disclose each of the features and relationships recited in claim 27 (which they do not), the Action has still failed to show a prior art teaching, suggestions, or motivation to combine the references to form the method recited in claim 27.

The Applicants respectfully submit that the attempts to combine the teachings of the references are clearly attempts at hindsight reconstruction of Applicants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Applicants' disclosure. It follows that it would not have been obvious to have modified the references in the manner alleged.

As discussed previously, Drummond does not qualify as prior art. In addition, even if Drummond qualified as prior art (which it does not), Applicants respectfully submit that the Office has not established *prima facie* obviousness with respect to claim 27. Drummond and Schneier do not disclose or suggest each and every element, feature, and relationship of the

claimed invention arranged in the manner recited in the claim, as is required to sustain the rejection. Nor is there any prior art teaching, suggestion, or motivation cited for modifying Drummond in view of Schneier so as to produce the claimed invention. Further, it would not have been obvious to one having ordinary skill in the art to have modified Drummond in view of Schneier to have produced the claimed invention. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 27 is improper and should be withdrawn. It follows that claims 28-30 which depend from claim 27 are also allowable.

Claim 31

Claim 31 is an independent claim which is directed to a method, The method comprises:
a) receiving a request at an ATM to digitally sign an electronic document visually displayed by the ATM; b) causing a digital signature and a digital time stamp to be produced for the electronic document; and c) causing the digital signature and the digital time stamp to be attached to the electronic document.

Applicants disagree with the Assertions made in the Action regarding the teachings of Drummond with respect to the steps recited in claim 31. Nowhere does Drummond disclose or suggest:

- receiving a request at an ATM to digitally sign an electronic document visually displayed by the ATM;
- causing a digital signature to be produced for the electronic document visually displayed by the ATM; or

- causing the digital signature to be attached to the electronic document visually displayed by the ATM.

As discussed previously, the portions of Drummond referenced at column 14, lines 10-28 discuss Java script and an HTTP record with an instruction used to operate devices which have digital signatures. Drummond does not disclose or suggest that the Java script or HTTP record with an instruction for operating devices which include digital signatures are displayed by an automated transaction machine. Thus Drummond does not disclose or suggest producing a digital signature for the electronic document "visually displayed by the automated transaction machine".

In addition, the Action admits that Drummond does not disclose or suggest: causing a digital time stamp to be produced for the electronic document; or causing the digital time stamp to be attached to the electronic document. However, the Action asserts that Schneier teaches that digital signatures usually include timestamps and it would therefore have been obvious to a person in the art at the time of the invention was made to modify the method disclosed in Drummond to allow for producing and attaching a digital timestamp to the electronic document. The Action asserts that this modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Schneier on page 38, lines 16-22.

Applicants disagree. The referenced portion of Schneier at page 38, lines 16-22 does not suggest modifying the method disclosed in Drummond as asserted in the Action. Further Schneier's discussion of digital signatures and digital time stamps does not disclose or suggest the features admitted as being missing from Drummond. Neither Schneier nor Drummond alone

or in combination disclose or suggest the method steps of: **causing a digital time stamp to be produced for the electronic document visually displayed by the ATM; and causing the digital time stamp to be attached to the electronic document visually displayed by the ATM.** In addition, neither reference discloses or suggests: **causing a digital signature to be produced for the electronic document visually displayed by the ATM; and causing the digital signature to be attached to the electronic document visually displayed by the ATM.**

As neither Drummond nor Schneier discloses or suggests each and every feature, relationship, and step recited in the claim, the Office has failed to establish *prima facie* obviousness. Furthermore, even if the applied references did separately disclose each of the features and relationships recited in claim 31 (which they do not), the Action has still failed to show a prior art teaching, suggestion, or motivation to combine the references to form the method recited in claim 31.

The Applicants respectfully submit that the attempts to combine the teachings of the references are clearly attempts at hindsight reconstruction of Applicants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Applicants' disclosure. It follows that it would not have been obvious to have modified the references in the manner alleged.

As discussed previously, Drummond does not qualify as prior art. In addition, even if Drummond qualified as prior art (which it does not), Applicants respectfully submit that the Office has not established *prima facie* obviousness with respect to claim 31. Drummond and

Schneier do not disclose or suggest each and every element, feature, and relationship of the claimed invention arranged in the manner recited in the claim, as is required to sustain the rejection. Nor is there any prior art teaching, suggestion, or motivation cited for modifying Drummond in view of Schneier so as to produce the claimed invention. Further, it would not have been obvious to one having ordinary skill in the art to have modified Drummond in view of Schneier to have produced the claimed invention. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 31 is improper and should be withdrawn. It follows that claim 32 which depends from claim 31 is also allowable.

The Dependent Claims

Each of the dependent claims depends directly or indirectly from an independent claim. The independent claims have been previously shown to be allowable. "If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious" (MPEP 2143.03). *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, it is asserted that the dependent claims are allowable on the same basis.

Furthermore, each of the dependent claims additionally recites specific features, relationships, and/or steps that patentably distinguish the claimed invention over the applied art. None of the applied art taken alone or in combination, discloses or suggests the features, relationships, and/or steps that are specifically recited in the dependent claims. Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features, relationships, and/or steps.

The New Claims

New claim 33 is an independent claim which generally corresponds to the subject matter recited in independent claims 1, 20, and/or 27. Support for claim 33 is found in the Specification, Drawings, and original claims.

Claims 34-41 depend from claim 33 and recite further features previously recited in the original claims and/or disclosed in the Specification and Drawings. None of the cited references alone or in combination discloses or suggests the features, relationships, and steps that are specifically recited in the new claims 33-41. These claims recite features, relationships and steps recited in the original claims and are allowable for at least the same reasons. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the new claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is respectfully submitted that the new claims are allowable for these reasons.

Additional Claim Fees

Please charge the fees associated with prosecution of one additional independent claim in excess of three (\$200) and nine additional total claims (\$450) and any other fee due, to Deposit Account No. 09-0428 of InterBold.

Conclusion

The applied art of Drummond, Zajkowski, and at least portions of Meurer do not qualify as prior art. Further, each of Applicants' pending claims specifically recites features and

relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



Ralph E. Jocke Reg. No. 31,029
231 South Broadway
Medina, Ohio 44256
(330) 722-5143